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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

555255-012611

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on February 28, 2011

Signature

*Debra Pejeau*Typed or printed name Debra Pejeau

Application Number

10/695,137

Filed

10/28/2003

First Named Inventor

Larry E. Hawker

Art Unit

2614

Examiner

Disler Paul

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

/Joseph M. Sauer/

Signature

☐

assignee of record of the entire interest.

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Typed or printed name

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☐

attorney or agent acting under 37 CFR 1.34.

February 28, 2011

Date

Registration number if acting under 37 CFR 1.34 _____

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐

*Total of _____ forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Hawker, et al.
Title : SYSTEM AND METHOD OF ACOUSTICALLY SAFE
AUTOMATIC HANDSFREE VOLUME ADJUSTMENT
Application No. : 10/695,137
Filed : October 28, 2003
Group Art Unit : 2614
Examiner : Disler Paul

REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Dear Sirs:

The Examiner has issued a Final Rejection of the pending claims. The Applicant hereby requests review of the Final Rejection prior to filing an appeal brief for the reasons set forth below. Any fees due should be charged to Jones Day Deposit Account No. 501432, ref: 555255-012611.

ARGUMENT

The Final Office Action issued on October 27, 2011 and rejected claims 25-26, 29-34, 37-43, and 45-46. Specifically, independent claims 25 and 33 are rejected under 35 U.S.C. §103 over the combination of Schmidt (U.S. 6,522,894), Kanevsky (U.S. 2003/0002688) and Yoo (U.S. 2004/0185919). Applicant respectfully submits that these rejections demonstrate clear error because the cited references fail to disclose or suggest each element of independent claims 25 and 33. The Office Action admits that the cited references fail to disclose each element of the claims, but still sustains an obviousness rejection without providing any reason why one skilled in the art would combine the deficient references. Applicant, therefore, respectfully requests that the rejections of independent claims 25 and 33 be withdrawn.

I. The Office Action Cannot Ignore Claim Elements

The rejection of independent claims 25 and 33 must be withdrawn because the cited references fail to teach or suggest each limitation of the claims. Because the Office Action fails to show how each limitation is disclosed or suggested by the cited references, the rejection is clearly in error and must be withdrawn.

Furthermore, a proper obviousness rejection could not be made because the cited references fail to disclose or suggest a situation in which “the mobile device is still held in close proximity to the user’s ear when the mobile device transitions from the handset mode of operation to the handsfree mode of operation” and subsequently “operating according to the safe volume profile” following the transition, as recited in claims 25 and 33. For example, the Schmidt reference describes a wireless communication device that can operate either in a regular “phone mode” or in a “radio mode.” In radio mode, the phone appears to handle communications in a half-duplex manner such that voice data is only transmitted when the user pushes a button (i.e., push-to-talk mode.) The Schmidt reference explains that the default setting is for the audio output to be through a loud speaker in radio mode and through a quieter speaker in phone mode. However, the Schmidt reference fails to suggest a quieter “safe volume” setting for the radio mode. And as the Office Action notes, the Schmidt reference never contemplates switching between its phone mode and its radio

mode during the middle of a call, and thus is not concerned with a situation where the phone is still held in close proximity to the user's ear when transitioning between modes.

The Yoo reference fails to account for the deficiencies of the Schmidt reference. Yoo merely discloses a detachable microphone/speaker combination for a phone. (Yoo, Figs. 1A-C). The detachable unit is always next to a user's ear, even when detached from the phone unit. *Id.* Therefore, Yoo never contemplates any change in volume, let alone a "safe volume" setting, because the phone and speaker are always being used in the same mode and at the same volume.

Kanevsky relates to preset volume limits for headphones. Kanevsky fails to disclose anything similar to maintaining a "safe volume" setting when switching modes of operation from a handset mode to a handsfree mode. Accordingly, Kanevsky fails to cure the deficiencies of the Schmidt and Yoo references.

The three references, alone, or in combination, fail to disclose each limitation of the independent claims. The Office Action fails to show otherwise, and as described above, it could not. The Applicant, therefore, requests that the rejection of independent claims 25 and 33 be withdrawn.

II. The Office Action Fails to Provide A Reason Why One Skilled in the Art Would Combine the Cited References

Recent court decisions may have given Examiners more latitude in handling obviousness rejections. But not one court decision allows an Examiner to provide no evidentiary support when proffering a reason to combine disparate references. And not one court decision provides that circular reasoning is an allowable basis for combining references, such that one skilled in the art would have a reason to combine the elements merely to obtain the combination. Accordingly, the rejections of independent claims 25 and 33 are in clear error and must be withdrawn.

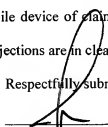
Independent claim 25 recites a "safe volume profile providing a default volume setting...selected to reduce the risk of damage to a user's hearing if the mobile device is operated in close proximity to the user's ear while in the handsfree mode of operation." Independent claim 33 contains a similar limitation. The Office Action admits that none of the cited references contain this limitation of claims 25 and 33. It concludes, however, that it would have been obvious to combine the cited references "which yield

unexpected [*sic*] result so as to merely protect the listener's hearing while listening to the audio sound according to such hands-free mode." (Office Action, pages 5 and 10).

The Office Action's conclusory assertion that one of ordinary skill in the art would combine the cited references merely to achieve the benefit of the combination is unsupported and is clear error. An obviousness rejection "cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007); *see also* MPEP § 2142. A proper rejection must include citing references that teach or suggest all features of the claimed invention and must be supported by a rationale for combining the elements that clearly leads to the combination. *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995); *Ruiz v. A.B. Chance*, 234 F.3d 654, 660 (Fed. Cir. 2000). The Office Action has failed to cite references that disclose each limitation of claims 25 or 33, and has further failed to provide any rational reason why one of skill in the art would combine the cited references. The circular reasoning that one of skill in the art would combine references for the sole reason of achieving the intended benefit of combining them cannot sustain an obviousness rejection. *See, e.g., KSR Int'l Co.*, 550 U.S. at 418. Accordingly, the Office Action has failed to meet its burden in the rejection of independent claims 25 and 33. The rejection, therefore, is in clear error and must be withdrawn.

A person skilled in the art would, therefore, have no reason to modify the Schmidt reference based on the teachings of Kanevsky, Yoo, or any other reference, to provide a safe volume profile, as recited in independent claims 25 and 33. Furthermore, even if one skilled in the art were to attempt such a combination, it would not result in the method or mobile device of claims 25 and 33. For at least these reasons, Applicants respectfully submit that the claim rejections are in clear error and must be withdrawn.

Respectfully submitted,



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